UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte HERBERT M. REYNOLDS
and RAYMOND BRODEUR,

Appeal No. 2005-1627
Application No. 10/035,990

ON BRIEF

Before WALTZ, KRATZ and JEFFREY T. SMITH, Administrative Patent Judges.
JEFFREY T. SMITH, Administrative Patent Judge.

REMAND TO THE EXAMINER

Appellants appeal the Examiner's final rejection of claims 1-3, 6-9, 11-16, 32-39, 51-65. The subject matter of claims 40-50 has been indicated as allowable and the subject matter of claims 4, 5, 10 and 17-31 have been objected to for depending on a rejected base claim. Because the issues are not ripe for appeal, we remand.

The subject matter on appeal can be grouped generally into three categories: Group I, claims 1-3, 8 and 60 directed to a design template for use with a seat; Group II, claims 11, 15, 16, 32-39 and 62-64 directed to various methods, including designing a seat and a method of establishing occupant accommodation; and Group III, claims 9 and 61 directed to a seat.

We note that in the Answer the Examiner has focused on the design template. However, the Examiner has failed to specifically indicate which portions of the cited references are being relied to teach the seat components and the process limitations of the method claims. We note that many of the method claims are quite detailed and include many steps. Which steps match up with which portions of cited references are unclear. We note that the Board is required by the Federal Circuit to analyze the claims on a limitation-by-limitation basis, with specific fact findings for each contested limitation and satisfactory explanations for such findings. *Gechter v. Davidson,* 116 F.3d 1454, 1457, 43 USPQ2d 1030, 1033 (Fed. Cir. 1997). The Examiner must meet an equivalent standard, because the Board of Patent Appeals and Interferences is a board of review and not a vehicle for initial examination. See 35 U.S.C. § 6(b)(2000).

In addition, the Examiner has not explicitly set forth how the claims are being interpreted. Such a step is required before a proper comparison with the prior art can be made. We note that the Federal Circuit also requires explicit claim construction, at least for any disputed limitation. *Gechter,* 116 F.3d at 1457, 43 USPQ2d at 1033.

Further, the Examiner should provide a discussion of the arguments presented by Appellants on pages 12 to 25 of the Brief. In particular, the Examiner should specifically address each of the arguments presented for the various claims discussed in the Brief. In addition to providing a response to Appellants' arguments in the Brief, the Examiner should address any additional arguments by Appellants appearing in the Reply Brief.

In light of the above facts, we feel it is premature to decide this appeal. More fact finding needs to be completed on this record by the Examiner to address the claimed method and seat. The Appellant should be given an opportunity to respond on the record. Particularly, the Examiner is required to point out on a limitation-by-limitation basis which portions of the references correspond to the limitations recited in the claims with explicit fact finding as to the scope and meaning of those limitations. It is important that ambiguous or obscure bases for decision do not stand as barriers to a determination of patentability.

This remand to the examiner pursuant to 37 CFR 41.50(a)(1) (effective September 13, 2004, 69 Fed. Reg. 49960 (August 12, 2004), 1286 Off. Gaz. Pat. Office 21 (September 7, 2004)) is made for further consideration of a rejection. Accordingly, 37 CFR 41.50(a)(2) applies if a supplemental Examiner's Answer is written in response to this remand by the Board.

TIME FOR TAKING ACTION

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a)(1)(iv)(effective Sep. 13, 2004; 69 Fed. Reg. 49960 (Aug. 12, 2004); 1286 Off. Gaz. Pat. Office 21 (Sep. 7, 2004)).

REMAND

THOMAS A. WALTZ
Administrative Patent Judge

PETER F. KRATZ
Administrative Patent Judge

JEFFREY T. SMITH
Administrative Patent Judge

BOARD OF PATENT APPEALS AND INTERFERENCES

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